

be pending in this application. The amendment to the claims does not add any new matter.

1. Rejection of claims 17-18 under 35 U.S.C. §112, 1st paragraph

The Examiner has rejected claims 17-18 under 35 U.S.C. §112, 1st paragraph as being non-enabled because "the specification...does not reasonably provide enablement for in vivo treatment of an illness treatable by PDE4 inhibition (claim 17) or of an airway disorder".

RESPONSE

Applicants respectfully traverse this rejection. However, solely to remove the basis for this rejection, applicants have canceled claims 17-18 without prejudice to or disclaimer of the subject matter contained therein.

Accordingly, applicant respectfully requests that the Examiner withdraw this rejection of claims 17-18.

2. Rejection of claims 1-13, 15 and 17-18 under 35 U.S.C.

§103(a)

The Official Action states that claims 1-13, 15 and 17-18 are rejected under 35 U.S.C. §103(a) over WO 2004018451 to

Hatzelmann, et al.

RESPONSE

As to claims 17-18, applicants respectfully point out to the Examiner that claims 17-18 have been canceled without prejudice, rendering the basis for the rejection of these claims moot.

Regarding pending claims 1-13 and 15, applicants respectfully traverse this rejection. The Examiner is correct that the Hatzelmann, et al. reference is only available as prior art under 35 U.S.C. §102(e).

However, since, at the time the invention was made, it was commonly owned with the Hatzelmann, et al. application, this reference is disqualified as prior art under 35 U.S.C. §103(c).

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection of claims 1-13 and 15.

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,
THE NATH LAW GROUP

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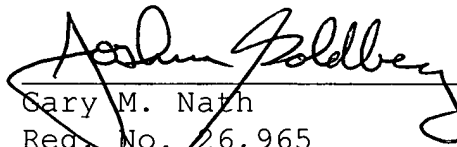
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